REMARKS/ARGUMENTS

Claims 1, 2, 4, 5, and 7-10 are pending in the present application. In the Office Action mailed July 5, 2005, the Examiner objected to Applicant's claim of priority and rejected claims 1, 2, 4, 5, and 7-10 under 35 U.S.C. § 103.

Reconsideration is respectfully requested in view of the following remarks.

A.   Claim of Priority

The Examiner stated that the present application lacked the necessary reference to the prior application including the current status of the parent nonprovisional application. See Office Action, page 2. Applicants have amended the specification to include the current status of the parent nonprovisional application.

B.   Rejection of Claims 1, 2, 4, 5, and 7-10 under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 2, 4, 5, and 7-10 under 35 U.S.C. § 103(a) based on U.S. Patent No. 4,977,515 to Rudden et al. (hereinafter, "Rudden") in view of U.S. Patent No. 5,544,036 to Brown, Jr. et al. (hereinafter, "Brown"). This rejection is respectfully traversed.

The M.P.E.P. states that

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.
>
> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the

teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the applied references. The applied references do not teach or suggest all of the limitations in these claims.

Independent claim 1 is directed to a curtailment module for enabling an energy provider to send a request to curtail energy use to a user. Claim 1 recites "a code generator stored in the memory and executable by the processor to generate a verification code using the curtailment message and the history data as inputs." Applicants respectfully submit that neither Rudden nor Brown teach or suggest this limitation.

In the Office Action, the Examiner asserts that

> Rudden teaches a curtailment module for enabling an energy provider to send a request to curtail energy use to a user, the curtailment module comprising ... a code generator stored in the memory and executable by the processor to generate a verification code, using the curtailment message and the history data as inputs, to verify compliance with the request (Fig. 11).

Office Action, pages 2-3. Applicants respectfully disagree.

The Examiner cites Figure 11 in support of his assertion that Rudden teaches "a code generator." However, though Rudden describes Figures 1-9 in detail, the only explicit reference to Figure 11 is found in the Brief Description of the Drawings. See Rudden, col. 3, lines 34-36 ("FIGS. 10, 11 and 12 contain a flow chart illustrating the operation of the load management module embodying the present invention"). In the Office Action, the Examiner provides his interpretation of Figure 11. See Office Action, pages 3-4. However, Applicants respectfully submit that they cannot find anything in the specification that supports this interpretation.

Without any guidance from the specification, one of skill in the art would not interpret Figure 11 beyond what it explicitly discloses. Figure 11 discloses "a flow chart illustrating the operation of the load management module." Id. The flow chart also includes a "Record event and power" step, a "Record event" step, and a "Store Present Date/Time" step. See id., Figure 11. However, Figure 11

does not teach or suggest "a code generator" or "generat[ing] a verification code," as recited in claim 1.

Conversely, the Examiner asserts that "Rudden clearly teaches the code in the memory is used to determine if the customer is in compliance with an energy curtailment request (Col. 6, lines 30-37)." Office Action, page 3. Applicants respectfully disagree. The cited portion of Rudden states:

> In one mode of operation, the device would remain in the customer's possession over the summer months and the customer at the end of the summer would remove the device and return it to the utility. The utility would then read out the data recorded in the memory unit U3 and determine whether or not the customer had complied with the intent and is entitled to a suitable reward or compensation.

Rudden, col. 6, lines 30-37. This section of Rudden states that the data in the returned device's memory is "read out" and then the utility company "determines whether or not the customer had complied" with the utility company's intent. Nowhere in this section is "a code generator," as recited in claim 1, taught or suggested. Claim 1 requires that the code generator "generate a verification code." However, nothing in this section of Rudden teaches or suggests this limitation. The "data recorded in the memory unit U3" is not "a verification code." Rather, Rudden discloses that the recorded data is "the date and time at which an override input was received." Id., col. 5, lines 51-52. Consequently, this section of Rudden does not teach or suggest "a code generator" or "generat[ing] a verification code," as recited in claim 1.

As discussed above, there is no disclosure in Rudden regarding the flow chart in Figure 11. Applicants submit that flow chart in Figure 11 may disclose "memory for recording in the device its history of operation." Rudden, col. 2, lines 45-46. However, Applicants respectfully submit that recording the device's "history of operation" is not "generat[ing] a verification code." Claim 1 makes a distinction between "history data" and a "verification code." Specifically, claim 1 requires that the code generator "us[e] the ... history data as [an] input[]" in order to "generate [the] verification code." Rudden teaches that the device's "history of operation" may be recorded. However, Rudden

does not teach that the "history of operation" is used to "generate a verification code." Therefore, Rudden does not teach all the limitations of claim 1.

Brown does not make up for the deficiencies of Rudden. Brown merely discloses an energy management and home automation system. Furthermore, the Examiner did not assert nor could Applicants find any disclosure in Brown that teaches or suggests "a code generator," as recited in claim 1. Accordingly, neither Rudden nor Brown, alone or in combination, teach or suggest all of the limitations in claim 1.
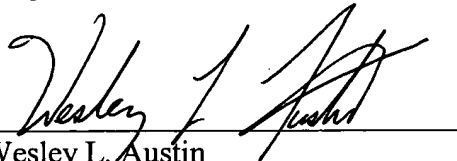
In view of the foregoing, Applicants respectfully submit that independent claim 1 is patentably distinct from the cited references. Claims 2, 4, 5, and 7-10 depend directly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 1, 2, 4, 5, and 7-10 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

C.   Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicants

Date: September 29, 2005

MADSON & METCALF
Gateway Tower West
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: 801/537-1700